

## REMARKS

Claims 65-101 are pending in the application. The independent claims and all of the dependent claims have been amended to include language relating to some of the undulating strands having a dielectric coating and being electrically insulated from the undulating strands forming the electrode. New claims 102-105 recite the same language as the amended claims regarding the electrically insulated undulating strands. Support for the amended claims can be found throughout the specification and drawings, and in particular at page 21, lines 11-23 and FIG. 5, and page 23, line 25 through page 24, line 24, and FIGS. 6A and 6B. No new matter is presented. Claims 69, 78, 91, and 97 have been canceled. Reconsideration is respectfully requested.

### Double Patenting

Applicant apologizes to the Examiner for filing a Terminal Disclaimer in the previous response addressing only one of the applications cited by the Examiner. A new Terminal Disclaimer is being filed concurrently herewith to address all of the double patenting rejections.

### Claim Rejections Under 35 U.S.C. § 102

Claims 65-66, 68, 74-75, 77, 93-94, and 96 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Lau et al. (U.S. Patent Publication 2002/0019580 A1). Applicant respectfully traverses. Referring to claim 65 of the application, Lau et al. does not disclose a first set of undulating strands forming an electrode and a second set of undulating strands having a dielectric coating and being electrically insulated from the first set of undulating strands. Lau et al. does not disclose a dielectric coating on any of the strands or rows of undulating hinge elements. The other independent claims have been similarly amended. Accordingly, the present invention is patentably distinguishable over Lau et al. and it is respectfully urged that the rejection under 35 U.S.C. § 102(b) be withdrawn.

### Claim Rejections Under 35 U.S.C. § 103

Claims 65-101 have been rejected under 35 U.S.C. § 103(a) as being obvious over Alferness et al. (U.S. Patent No. 6,169,922) in view of Lau et al. (U.S. Patent Publication 2002/0019580 A1). Applicant respectfully traverses. As set forth above, the independent claims of the application have been amended to recite undulating strands having a dielectric coating and being electrically insulated from undulating strands forming the electrode. The primary reference, Lau et al., does not teach or suggest coating one set of undulating strands with a dielectric coating in order to electrically insulate those strands from undulating strands forming an electrode. Similarly, Alferness et al. does not teach or suggest (1) undulating strands of hinge elements; (2) undulating strands forming an electrode; (3) undulating strands having a dielectric coating; (4) undulating strands being electrically insulated from other undulating strands; and (5) the jacket of Alferness et al. is formed of a polymer, not a metal alloy. Not only does Alferness et al. not teach or disclose undulating strands having a dielectric coating, but there is no motivation to combine Lau et al. with Alferness et al. Alferness et al. already has an electrode interwoven through the polymer jacket surrounding the heart. Why would a person having ordinary skill in the art add the hinge elements of Lau et al. to the jacket of Alferness et al. with the resulting structure having an electrode wire (Alferness et al.) weaving through the metal alloy hinge elements (Lau et al.)? The wire to wire overlap (electrode and hinge elements) would render the entire device an electrode. There simply is no motivation to make this combination. The polymer jacket of Alferness et al. is a constraint device whose purpose is to limit the expansion of the heart during diastole. In contrast, Lau et al. is a cardiac harness formed of an expandable and elastic metal alloy such as Nitinol that applies a gentle pressure on the heart as it expands, but does not limit diastolic filling, and provides systolic augmentation throughout the cardiac cycle. A person having ordinary skill in the art would not combine the constraint polymer jacket device of Alferness et al. with the passive elastic cardiac harness of Lau et al. in order to

add elastic hinges to Alferness et al. There is simply no motivation to completely change the Alferness et al. constraint jacket by a person having skill in the art.

Apart from the lack of motivation to combine Alferness et al. and Lau et al., there is no evidence that the combined device has a reasonable chance of success of performing as intended. Boehringer Ingelheim Vetmedica, Inc. v. Shering-Plough Corp., 320 F.3d 1339, 1354 (Fed. Cir. 2003). A showing of obviousness requires a motivation or suggestion to combine or modify prior art references, coupled with a reasonable expectation of success. Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 229 F.3d 1120, 1124-25 (Fed. Cir. 2000). The Examiner has provided no evidence, nor is there evidence available in either Alferness et al. or Lau et al., that would lead a person having ordinary skill in the art to add hinges from Lau et al. to the polymer mesh jacket of Alferness et al. The metal wire electrode would cause severe abrasion issues in the Alferness et al. jacket as the heart continuously expands and contracts during the cardiac cycle. Further, if the hinges of Lau et al. were added to the jacket of Alferness et al., the wire electrode interwoven through the hinges would also cause severe abrasion and metal fatigue issues. There is no reasonable expectation of success in combining the Lau et al. and Alferness et al. devices.

As stated, Alferness et al. is a constraint device intended to "limit" diastolic filling. In direct contrast, Lau et al. is a passive restraint device with elastic hinges that do not limit diastolic filling. Thus, a person having ordinary skill in the art would not completely change the structure of Alferness et al. which would then change the intended use and result from a device that has a pre-determined expansion limit to one with no expansion limit. There is no motivation to combine and no evidence a combined device would have a reasonable expectation of success, and there is substantial evidence reflecting the differences between the two prior art devices.

In conclusion, claims 65-68, 70-77, 79-90, 92-96, and 98-105 remain pending in the application for further prosecution. Reconsideration is respectfully requested. If a

telephone conference would facilitate prosecution of the application, the undersigned can be reached at (310) 824-5555.

Respectfully submitted,

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